

REMARKS

Claims 2-9, 11-18, and 20-48 are currently pending in this application, claims 28, 32, 37, and 41 being independent. Applicants respectfully request reconsideration and withdrawal of the outstanding rejections in light of the following remarks.

Official Action

In the outstanding Official Action, the Examiner rejected claims 2-9, 11-18, 20-27, 32, 37, and 41 under 35 U.S.C. § 103(a) as being unpatentable over *Enomoto et al.* (USP 5,974,401); and rejected claims 28-31, 33-36, 38-40, and 42-47 under 35 U.S.C. § 103(a) as being unpatentable over *Enomoto et al.* in view of *Garfinkle* (USP 6,017,157).

Prior Art Rejections

With regard to the Examiner's rejection of claims 1-9, 11-18, 20-31, and 32-48 under 35 U.S.C. § 103(a), Applicants respectfully traverse these rejections.

In support of the Examiner's rejection of claim 28, the Examiner takes official notice that shell extensions and shells access operating system commands on their own or with application interfaces.

In order to sustain a claim rejection under 35 U.S.C. § 103(a), it is respectfully submitted that the Examiner must meet his burden to establish a *prima facie* case. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined)

must teach or suggest all of the claim limitations." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

It is respectfully submitted that the present invention as set forth in claim 28 recites, *inter alia*, a network photo print system comprising an operating system, including an operating system desktop shell interface and an extension to the operating system desktop shell interface, the shell extension supplying third image data to the user station. It is respectfully submitted that, while the Examiner takes official notice that shell extensions and shells access operating system commands on their own or with application interfaces, which Applicants respectfully traverse, the Examiner has failed to provide any citations to the *Enomoto et al.* reference teaching an operating system, including an operating system desktop shell interface and an extension to the operating system desktop shell interface, the shell extension supplying third image data to the user station, as recited in claim 28. As such, the Examiner has failed to meet his burden in establishing a *prima facie* case of obviousness under 35 U.S.C. § 103(a). Thus, the rejection of claim 28, together with any claims dependent thereon, should be withdrawn.

With regard to the Examiner's rejection of claim 32, the Examiner states that *Enomoto et al.* teaches uploading the digital image to the external network entity or another external network entity in accordance with the previously exchanged ordering information, citing to col. 2, lines 23-60.

It is respectfully submitted that *Enomoto et al.* teaches a digital print order and delivery method and system. Specifically, *Enomoto et al.* teaches

Then the order receiver, i.e. a particular photofinisher, is designated, and data transfer command is entered, whereupon the processed digital image data and the print order data are sent to the designated photofinisher. (Col. 2, lines 23-27).

Additionally, *Enomoto et al.* further teaches

When to pursue the print order, the order sender transfers the entire print order data, including the digital image data and the print order data, to the reception processing device. (Col. 2, lines 51-53).

In contrast, the present invention as set forth in amended claim 32 recites, *inter alia*, a method of on-line ordering of image-related services comprising uploading the digital image to the external network entity or another external network entity subsequent to exchanging ordering information. It is respectfully submitted that *Enomoto et al.* teaches transmitting the order information together with the digital image data. *Enomoto et al.* fails to teach uploading the digital image to the external network entity or another external network entity subsequent to exchanging ordering information. As such, it is respectfully requested that the outstanding rejections of claim 32, together with claims dependent thereon, be withdrawn.

It is respectfully submitted that independent claims 37 and 41 contain elements similar to those discussed above with regard to claim 2. As such, it is respectfully submitted that claims 37 and 41, together with claims dependent thereon, are allowable for the reasons set forth above with regard to claim 32.

CONCLUSION

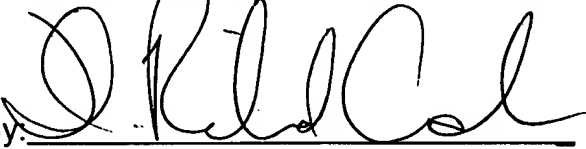
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisin (Reg. No. 52,327) at the telephone number below.

Applicants respectfully petition for a one (1) month extension of time pursuant to 37 C.F.R. §§ 1.17 and 1.136(a). A check in the amount of \$110.00 in payment of the extension of time fee is attached.

If necessary, the Commissioner of hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachment: Version With Markings to Show Changes Made

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

The claims have been amended as follows:

32. (Amended) A method of on-line ordering of image-related services, comprising:

receiving, at a user station, a digital image;

establishing a network connection between said user station and an external network entity;

exchanging ordering information, between said user station and said external network entity, for an image-related service for said digital image; and

uploading said digital image to said external network entity or another external network entity subsequent to exchanging [in accordance with the previously exchanged] ordering information.

37. (Amended) A computer program embodied in a computer-readable medium for on-line ordering of image-related services, comprising:

a receiving code segment for receiving, at a user station, a digital image;

a network connection code segment for establishing a network connection between said user station and an external network entity;

an ordering code segment for exchanging ordering information, between said user station and said external network entity, for an image-related service for said digital image; and

an uploading code segment for uploading said digital image to said external network entity or another external network entity subsequent to exchanging [in accordance with the previously exchanged] ordering information.

41. (New) A computer signal for on-line ordering of image-related services, comprising:

a receiving segment for receiving, at a user station, a digital image;

a network connection segment for establishing a network connection between said user station and an external network entity;

an ordering segment for exchanging ordering information, between said user station and said external network entity, for an image-related service for said digital image; and

an uploading segment for uploading said digital image to said external network entity or another external network entity subsequent to exchanging [in accordance with the previously exchanged] ordering information.